

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of  
Douglas D. DeMasi, Sr.

SN : Art Unit 3712  
Filed : Examiner Miller, B

For "Universal Flying Hawk"

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Poughkeepsie, NY 12603-5521  
April 30, 2001

Commissioner of Patents and Trademarks  
Washington, DC 20231

PRELIMINARY AMENDMENT

Sir:

To set up a continuation-in-part patent application under 37 CFR 1.53(b)(2) of patent application Ser. No. 09/313,566 filed 5/14/99 by Douglas D. DeMasi, Sr. for "Universal Flying Hawk", and in response to the FINAL Office Communication mailed 1/31/01 and the Advisory Action mailed 4/13/01 therein, kindly amend the substitute specification and new claims (both attached to the Amendment filed 9/5/00) of 09/313,566 application as follows:

In the Specification:

Before the section "1. Field of the Invention" but after the line "INTRODUCTION" on page 1 of the substitute specification, insert, per 37 CFR 1.78, a new section as follows:

0. Benefit of Earlier Application

This is a continuation-in-part application claiming the benefit of the earlier filing date of prior filed copending nonprovisional application 09/313,566 filed 5/14/99 by Douglas D. DeMasi for "Universal Flying Hawk".

Rewrite the 1<sup>st</sup> paragraph on page 3 of the substitute specification as follows:

A more specific object of the invention is to provide a recreational product that can be towed by a power boat on the water, and can thereafter gotten airborne and kept airborne with complete control by the rider.

Rewrite the 8<sup>th</sup> paragraph on page 3 of the substitute specification as follows:

A still another object of the invention is to provide an airborne product whose wing-like portion can also be used as a wakeboard or rideable element going through the water or riding the ocean or lake waves or down rivers.

Rewrite the 9<sup>th</sup> paragraph on page 3 of the substitute specification as follows:

Yet another object of the invention is to provide a detachable portion which comes out very easily from a socket in the wing-like portion and that is very easy to put back together with the rest of the product.

Rewrite the first three full paragraphs on page 5 as follows:

A disconnected fuselage, when inverted to place its fins below, may be used as a surfboard; the fins may be reversed to improve the surfboard action. The surfboard may be used in conventional fashion to ride the ocean waves or going down rivers, or it may be towed via a hook hole on its front end. The hook hole may also be part of the mechanism for coupling the fuselage and the wing-like body together. The mechanism may include a snap hook releasable by a movable control element or hand strap.

A unique feature of the invention is that three toys are readily available in one recreational product. Assembled, there is a toy which can be pulled through water and through the air, and in the later case even function as a glider; it can even be used as a snow toy. Disassembled, the front or wing-like body may be used as a wakeboard or rideable element; the surfboard-like fuselage or tail section may be used as a rideable element, e.g. a wakeboard or a surfboard in conventional fashion or towed.

An advantage of the invention is that both the wing-like body and the surfboard-like fuselage or tail section may be made of inflatable materials that lend themselves to minimum storage and transportation requirements. The inflatable materials provide especially good flotation materials usable in the event of mishap, for safety purposes.

Rewrite the paragraph on the bottom of page 5 and the top of page 6 as follows:

A further advantage of the invention is that when used airborne, it helps the rider to overcome any fear of heights. Thus the rider, and any passenger, feel true freedom through the air - simply flying through the air with the greatest of ease and with unbelievable control because of the design features of tail, fuselage, fins on the bottom of the wing, the configuration of the wing, the span of the wing, and the design of the wing. The rider can truly feel in control of his own destiny. And if he ever wants to release for any reason whatsoever, from the power boat that is pulling him or them, he or she simply releases the tow rope clip and glides down to the water very easily and very safely.

Rewrite the two full paragraphs on page 7 as follows:

Referring now more particularly to the drawings, there is shown in Fig. 1 an inflatable recreational product generally indicated by the numeral 10. The product 10 includes a wing-like body or section or portion or wing generally indicated by the numeral 12, and a surfboard-like fuselage or tail section or portion generally indicated by numeral 14. A rearward facing opening or socket 16 (Fig. 2) in the center of the rear end of the wing-like body or wing 12 receives the forward end 18 of the fuselage or tail section 14 in the assembled recreational product 10. The opening 16 and front end 18 may be complementary but non-circular in cross-section, to aid in preventing rotational movement between the two parts.. Suitable straps and/or VELCRO, including brace elements 17 extending rearward about the opening 16 from the rearward edge of the wing-body, are in place to hold the parts 12 and 14 together with the front end 18 of the fuselage 14 in the wing-like body opening 16. The inner

end of the opening or socket 16 may incorporate a snap hook for engagement with the fuselage front-end hole 56 to help secure the two parts together. The snap hook may be releasable by making the hand strap 27 first rotatable and then vertically movable, and employing a suitable mechanism there between.

As best seen in Figs. 1 and 3, the wing-like body 12 on its upper surface (which is non-slip) carries, as rider control elements, inner and central, a set of conventional foot and hand straps 20; somewhat further spaced apart and more rearward, a set of conventional foot and hand straps 22; and outside and rear, a set of conventional foot and hand straps 24. An extra set of conventional foot and hand straps 26 may be forward of the hand straps 22. The straps are foot straps for standing control, whether being towed, or surfing or skiing, and may include extended hand straps for standing stability while being towed; they are hand straps for lying down control. The multiple sets of foot and hand straps accommodate different sized riders, and one or more riders; when lying down, changing hand straps facilitates weight redistribution for control purposes, both on water and snow and in the air. Alternatively, the non-slip surface could be a VELCRO component, and the other VELCRO component could be used on the bottom of shoes or on the outer and gripping side of gloves in lieu of the straps.

Rewrite the 3<sup>rd</sup> full paragraph on page 8 as follows:

Of course, the wing-like body 12 and surfboard-like fuselage or tail section 14 may also be made from fiberglass, wood, anodized aluminum, heavy duty PVC, polyester or other synthetic materials. If desired, a bi-or tri-wing design may be built, so that airborneness can be had at lower speeds.

Rewrite the 2<sup>nd</sup> full paragraph on page 9 and the paragraph on pages 9 and 10 as follows:

The fundamental structure of the surfboard-like fuselage or tail section is basically that of a conventional inner bladder of one or more compartments covered by an outer protective shell. The upper surface 50 (Figs. 1 and 2) of the protective shell is a non-slip surface (that is, non-slippery when wet to ordinary human-applied pressures). The non-slip surface 50 bears rider control elements such as

foot straps 52 constituting the normal water-ski straps, and ankle and leg straps 54 for lying-down rider positions on the assembled recreational product. The front end 18 of the fuselage may be formed with a hole 56 for towing as a board.

To use the product, the product and its parts could be transported to a lake, stream or ocean, in non-inflated condition. On arrival, they would be inflated in conventional fashion. The two parts could then be assembled, the front end 18 of the fuselage 14 being inserted into the opening or socket 16 of the wing-like body 12 and secured in place by suitable straps and/or VELCRO and snap hook. The recreational product 10 could then be placed in water and the tow line 44, floating behind the idling boat 46, attached to its tow ring 42; and rider mounted, suitable access being made to the appropriate control elements for the position assumed. The boat driver, after being instructed on the desired activity, whether water only or water and airborne action, would then be signaled to take up any rope slack and proceed properly for the desired activity. The rider would control the action of the recreational product through interaction via one or more of the control element straps 20, 22, 24, 26, 27, 52, and 54, depending on whether he or she was standing, sitting, lying down or kneeling. If the boat 46 is speeded up to where the recreational product became airborne, the product remains airborne until either the boat speed is reduced or the tow cable 44 is uncoupled by the rider and the product descends in glider fashion. In a strong wind, the product can also be used as a kite.

Rewrite the penultimate and last paragraphs on page 10 to read as follows:

Steering on water is accomplished by shifting your weight right or left: shifting the weight right results in right turns; shifting the weight left results in left turns. When the speed is sufficient, shifting the weight backwards will cause the product to become airborne. Keeping the weight back will cause the product to reach its maximum altitude, considering the tether and speed and wind conditions. To return to the water, either the weight is shifted forward, or the power boat 46 is slowed down.

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In use as a disassembled recreational product, either or both of the wing-like body 12 and the fuselage or tail section 14 may be used. The wing-like section 12 may be put to use as a wakeboard or surfboard or water ski being towed by the boat 46. The fuselage or tail section 14 may be used as a water ski or wakeboard, or inverted and used as a surfboard with the fins 48 being reversed to present their vertical edges forward.

In the claims:

Add a claim:

43. In a rider recreational product for skimming on water, sliding on snow, or flying through the air, a product first surface of a VELCRO-like component for engagement a human, and a second surface of a complementary VELCRO-like component carried by the human for coacting with the first surface.

Remarks/Arguments (37 CFR 1.111)

This is a preliminary amendment to convert the original application into a continuation-in-part application and to place the later in condition for allowance.

Claims 21-42 were pending in the original application and are pending in this continuation-in-part application. Claims 21-24 stand finally rejected. Claims 33 and 37 were indicated as allowable if rewritten to overcome the rejections under 35 USC 112, 2<sup>nd</sup> paragraph, set forth in the Final Office action and to include all of the limitations of the base claim and any intervening claims.

The Specification provided with the amendment filed 11/17/2000 was "finally objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure", the examiner alleging that "The original disclosure fails to support the new subject matter...": the filing on this continuation-in-part application renders the issue moot. Applicant continues to urge that the substitute specification did not involve new subject matter.

Claims 15, 16, and 19 (later treated renumbered as 35, 36, and 39?) were finally objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Reconsideration is requested. Each of the claims further limits the subject matter of a previous claim. Claim 15 further limits the "thin, wide body" of claim 14 by requiring the addition of "a tow hook secured to the pointed central forward portion". Claim 16 further limits the "thin, wide body" of claim 14 by requiring the addition of "fins that extend longitudinally on its underside". Claim 19 further limits the "rider recreational product" of claim 18 by requiring the addition of "a tow hook secured to the front end of the first section".

Claims 21-42 were finally rejected under 35 USC 112, 1<sup>st</sup> paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, the Examiner alleging that "it is not described in the specification on how a first section is usable as a wakeboard. It is not described in the specification how the board comprising a thin and flat portion, a wider rear end and thin fins are usable as a fuselage or tail section. It is not described in the specification on how a somewhat pointed central forward portion, a wide rearward portion, and central rearward portion useable as a wing of a waterborne and airborne vehicle. It is not described in the specification on how a first section is independently usable as a wakeboard." Reconsideration is requested and allowance is deemed in order as the issues have been rendered moot by the filing of this continuation-in-part application, and the amendments herein making even more clear the subject matter being disclosed claimed.

The Examiner has apparently renumbered applicant's claims 1-22 as claims 21-42, respectively. Applicant has renumbered his claims accordingly.

Claims 21-42 were finally rejected under 35 USC 112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 21, the Examiner queried what is meant by "usable as a wakeboard and usable as a surfboard or ski". The word "wakeboard" has been replaced by the phrase "rideable element", rendering the issue moot though the wing is now specifically indicated as usable as a wakeboard. Applicant means that the "skimming on water and flying through the air" product "first section" must be independently usable as a rideable element, and a second section must be independently usable as a surfboard or ski. No one has invented such a combination before.

With respect to claim 21, the Examiner stated "there is lack of antecedent basis for the limitations 'the wing', 'the fuselage', and 'the section'". Applicant has amended claim 21 to specify that a product "having a wing and a fuselage or tail section". Applicant apologizes for the omission.

With respect to claim 22, the Examiner was unsure as to what is meant by "control elements". By "control elements", applicant meant elements such as the hand and foot straps 20. See lines 16 and 17 of the substitute specification.

With respect to claim 24, the Examiner was unsure as to what is meant by "on its underside". By "on its underside", applicant means surfaces such as his wing lower surface 28 which is in the water when being towed by a boat. See lines 10-19 on page 8 of the substitute specification.

With respect to claim 28, the Examiner was unsure of the scope of the claim when the claim refers to "a board usable as a fuselage or tail section of a recreational" product. Applicant intends the claim to cover an article usable as a fuselage or tail section of a recreational product, also having the characteristics recited after the word "comprising". The Examiner also was unsure as to what is meant by "wider rear end". Applicant means that the back or hind part of the elongated portion is wider than the rest of it. The Examiner also was unsure "if the thin fins or the wider-rear-end surface that are



upwardly when the board is attached to the product". Applicant has further amended the claim by inserting "and" after "surface" in line 5 to make very clear that the identified phrase further limits "thin fins".

With respect to claim 33, the Examiner was unsure as to what is meant by "inflatable bladder". Applicant meant to reference a bladder such as the "conventional inner bladder" of line 12, page 9, of the substitute specification. Bladders, by definition, are distensible sacs. The penultimate line, page 10 of the specification, addresses deflating it.

With respect to claim 34, the Examiner was unsure what is meant by "somewhat pointed central forward portion". Applicant meant wing portions like his "central front end 38. See line 20, page 8 of his substitute specification. To make the matter more clear, he has specifically amended claim 34 (and its dependent claim 35) so that "a somewhat pointed central forward portion" now reads "a central front end portion".

With respect to claim 37, the Examiner queried what is meant by "non-slick". Page 9, lines 13-16 identify the upper surface 50 of the fuselage as a non-slip surface, and that it bears rider control elements such as foot straps 52. The specification now more specifically sets forth what a non-slip surface means.

Claims 21-32(42?) were rejected, "as best understood", under 35 USC 102(b) as being anticipated by Brooke, the Examiner noting, regarding claims 1 and 18 (now claims 21 and 38), that "the 'wing' and the 'fuselage or tail section' are not positively claimed in the body of claim; therefore, the prior art need not show a 'wing', a 'fuselage section' or a 'tail section'". Applicant begs to differ with the Examiner. The claim calls for a product "comprising a first section constituting the wing of the product", and "a second section constituting the fuselage or tail section". "Comprising" means "including the following elements but not excluding others". *Moleculon vs. CBS*, 229 USPQ 805 (CAFC 1986). Applicant urges therefore that the "wing" and the "fuselage or tail section" are thus positively claimed in the body of

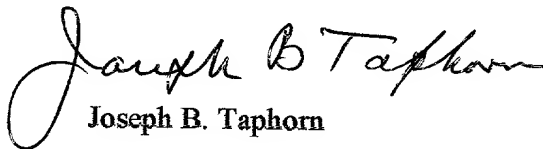
claim 21 and 38. Applicant has rendered this more clear by amending the preamble in claims 21 and 38 to specify a "product having a wing and a fuselage or tail section". Applicant urges that the rejection of claims 21 and 38 under 35 USC 102(b), is improper.

Regarding claims 22, 29 and 32; claim 23; claims 24, 36, 41 and 42; claims 25 and 26; claims 27 and 40; claim 28; claims 30 and 31; claim 34; and claims 35 and 39; applicant urges that these issues are moot in view of the patentability of the base claims.

Applicant notes the allowability of claims 33 and 37 if rewritten. Applicant believes that his amendments of the base and any intervening claims have overcome the rejections under 35 USC 112, 2<sup>nd</sup> paragraph.

Wherefore the continuation-in-part application is deemed to have been placed in condition for allowance which favorable action at an earlier date is respectfully requested.

Respectfully submitted,

  
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Attachment

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Joseph. B. Taphorn